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No. 75-310

In the
Supreme Court of the United States
October Term, 1975

SPERRY RAND CORPORATION,
Petitioner,

vs.

DEERE & COMPANY,
Respondent.

On Petition for Writ of Certiorari to the
United States Court of Appeals for the Ninth Circuit

BRIEF FOR RESPONDENT IN OPPOSITION

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REFERENCES TO THE RECORD BELOW

The Appendix to the Petition, which contains little apart from the opinions of the courts below, is page-numbered 1a-18a inclusive.

Believing that this Court should have convenient access to the key parts of the record below, such, for example, as the patent in suit itself, respondent has annexed to this brief its own Appendix, wherein such portions of the record are set forth. Respondent's Appendix, to avoid confusion, is page-numbered 1b, 2b, etc.

Since the respective appendices have distinctive page numbering, citations herein specify only the page number alluded to. Thus, a reference to page "14b" refers to the fourteenth page of the respondent's Appendix, bound inside the back cover of this brief, whereas a citation to page "14a" refers the Court to the page so numbered in the petitioner's Appendix.

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BRIEF FOR RESPONDENT IN OPPOSITION

The petition for writ of certiorari presents no question warranting this Court's attention, and the complaints it voices are without substance. No question of interest to the public is involved. This case is but a routine one in which the District Court struck down a patent that was plainly invalid, in a judgment which, on appeal, was unanimously affirmed.

Respondent agrees that this Court has jurisdiction to consider the petition, by virtue of United States Code, Title 28, §1254(1).

Neither of the issues alleged in the petition (pp. 2-3) to be the "Questions Presented" is in fact posed by this record. On the contrary, as just noted, the case is a routine one involving no debatable question.

Petitioner's "Statement of the Case" is faulty also, in that many of the "facts" paraded in it are at odds with the evidence and inconsistent with the District Court's findings. In this brief we shall so demonstrate, and we shall also show that petitioner's legal argument is lacking in substance.

ARGUMENT

I. Petitioner's Prayer For The Writ Of Certiorari Is Grounded Upon Factual Assertions Which Are False.

As to point after point, the factual premises of petitioner's argument are at odds with the record. Thus:

A. Petitioner's "Haybine" Was NOT An "Entirely New Type Of Farm Machinery"; It Was, On The Contrary, An Old Machine, Differing From Its Predecessors Only In Pedestrian, Obvious Ways. Nor Was The Prior-Art "Crose" Machine A Failure; It Was, On The Contrary, A Highly Successful Agricultural Tool.

The central theme of petitioner's argument, without doubt, is that the "mower conditioner" (which petitioner equates with its "Haybine" machine) was something broadly *new* in the world of agricultural machinery (Pet., 4, 5, 10, 25-26).

That premise, to be blunt, is nonsense. In truth, the prior-art "Crose machine" was a highly successful mower conditioner which, while made only in limited quantities by a small-scale manufacturer, did an outstanding job.

The prior-art mower conditioner known in this record as the "Crose machine" was a self-propelled machine manufactured and sold by H. L. Crose Company of Tulare, California. The Crose mower conditioner, like the machine described and claimed in petitioner's patent, had a power-driven sickle or "cutter bar", a rotating reel with tines which fed the hay to the cutter bar, an inclined guide plate or ramp, up which the freshly mown hay was pushed by the tines of the rotating reel, a pair

of full-width conditioning rolls to which the hay was fed by the reel, and a space between the rear edge of the guide ramp and the lower conditioning roll through which rocks and other foreign objects could drop to the ground (12b-13b, 28b-30b).

The conditioning rolls built into the Crose machines had smooth rather than aggressive surfaces; this was done, as Harvey L. Crose testified, because his machines were designed to work in alfalfa fields (28b-29b). Crose explained thus his reason for selecting, in an alfalfa machine, smooth rolls rather than rough-surfaced ones (29b):

> "My experience with a corrugated or rough surface roll, they are a little inclined to clip the tender end off of your alfalfa hay and you go out in the field and you could rake up a whole handful of your tender alfalfa just laying on the ground going to waste; and the object of my smooth roll was to crush the hay, let it pass through; whenever the wax is broke on the alfalfa, it allowed the moisture to all leave the stem at the same time. The stem is a little inclined to draw all the moisture from the leaves to try to survive, so your leaves get dry before your stem would get dry and the object of this was to crack that wax so that your moisture would all disappear at the same time and leave your leaves on your stem."

Asked about the speeds of the rolls and the reel in his machines, Crose testified (28b):

> "The reel and the rolls run just slightly faster than the forward speed of the machine, so that when the hay was cut, that your reel and rolls were a little aggressive to the hay."

Seven Crose machines, in all, were built—six in 1956 and one in 1958 (29b). All of those machines were basically alike, in that they utilized the same arrangement of cutter bar, reel, guide ramp, conditioning rolls, and rock space (28b).

Three of the seven Crose machines were sold to O. E. Martin of California's Imperial Valley, who used them in partnership with Wallace Tow in a business known as the Winter Cure Hay Company, beginning in the fall of 1956 and continuing into the following year (16b-19b). Financial losses were suffered when a siege of bad weather ruined a substantial part of the hay which had been mowed, conditioned, and left on the ground by the Crose machines; that resulted in a dissolution of the Martin-Tow partnership, but Tow continued for another year to use two of the Crose machines in a custom hay-conditioning business (19b-20b). Martin estimated that *5,000 acres of hay* had been mowed and conditioned with the Crose machines during the period in which he and Tow operated the machines in partnership (18b).

Another one of the Crose machines was bought by Raymond Pascoe of Bakersfield, California, who operated it for one complete haying season. As Mr. Pascoe explained it, the Crose mower conditioner "cut the hay nice, but it just wouldn't hold up for us" (22b). Because of the maintenance difficulties experienced with it, the Crose machine bought by Pascoe was eventually returned to the dealer from which it had been bought (22b).*

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* Pascoe's Crose machine is the one pictured in the magazine article "Haying Time Cut In Half", which was published in *Farm Management*, issue of May, 1957 (12b).

The Crose machine built in 1958 was sold to Marion Kattenhorn, who, leaving his job as a Crose employee, earned his living from May, 1958, through August, 1963, by mowing and conditioning with his Crose machine thousands of acres of alfalfa each year, on land near Shandon, California (33b-35b). Kattenhorn testified that his Crose machine "run beautiful" and *never plugged in clean alfalfa* (35b). He experienced "about average" maintenance and breakdown problems with his machine (35b).

William B. Roe, lessee of the land on which Kattenhorn's Crose machine was operated from 1958 through 1963, agreed that Kattenhorn had only "the normal expectancy breakdowns" with his machine (32b), even though 20% of the acreage on which the Crose machine was used was hillside or rolling, as opposed to flat land (31b).

Asked by petitioner's counsel whether it was not a fact "that Mr. Kattenhorn was paid for cutting hay whether or not he conditioned it" (31b-32b), Roe replied (32b):

> "The principle thing about that machine that we liked was his conditioner . . . the greatest thing for us there was the conditioning, the way that machine handled the hay."

Conclusive proof that the Crose machines operated well, and were not failures, was supplied by petitioner's "inventor" McCarty and its expert Bainer, both of whom witnessed the operation of a Crose machine petitioner bought from its original owner O. E. Martin (40b). Petitioner ran that machine through *ex parte* tests a few weeks prior to the trial; concerning those tests, Professor Bainer acknowledged (26b-27b) that the Crose

machine, though designed to mow and condition only alfalfa, did in fact work well *in a field of 54 inch rye*, and did not plug until petitioner's engineers raised its cutter bar eight inches to make it do so!

Anent those same tests, McCarty himself reluctantly conceded that, in operation, the Crose rolls "stripped" the reel, and admitted also that the Crose reel and rolls had the effect of speeding up the crop relative to the machine's ground speed (41b-42b).

The truth, in short, is that neither petitioner's "Haybine" machine nor the idea of mowing and conditioning hay in a single pass was new. The most that petitioner can legitimately claim is that its machine, unlike the earlier Crose machines, was designed for use with all sorts of hay crops, rather than just with alfalfa. That being so, petitioner substituted for Crose's smooth upper roll a rough-surfaced upper roll, admittedly old and well-known in farm machinery (24b-25b). And in so doing, petitioner made no invention. On the contrary, as its expert Professor Bainer acknowledged, petitioner merely followed the standard teachings of agricultural textbooks (25b).

In sum, the fact established by this record—and duly noted by both courts below—is that petitioner's "Haybine" machine was nothing more than an obvious modification of the prior-art Crose machine. Had petitioner told the Patent Office about the Crose machine (of which it was well aware, 23b), the patent in suit would never have been granted. Proof enough of that is the disgraceful pattern of argument by which petitioner secured its patent.

First off, petitioner characterized its invention thus (14b):

> "Consider Claim 34, original Claim 1. Such claim recites that 'extending upwardly and rearwardly from the mower toward the bite of the said rolls' is a 'guiding plate' which is 'fixed'. The reel has 'raking members' which travel 'in a circuitous path' and the 'guiding plate' is located 'in close proximity' to the path of the raking members. The raking members sweep rearwardly over the mower and then they convey the cut crop over the fixed plate and discharge the material 'directly into the bite of said rolls'. The rolls, rotating faster than the reel, strip material from the raking members."

Having thus told the Patent Office what its "invention" was, petitioner pointed out at length that none of the prior-art patents cited by the Patent Office disclosed a machine having all of the elements alluded to in the above quotation. But petitioner could *not* have made that argument had it done its duty and told the Patent Office about the Crose machine, for petitioner's quoted characterization of its "invention" described the Crose machine, down to the last detail!

B. Attenuation Of The Crop, Now Touted By Petitioner As The Nub Of Its "Invention", Is A Trial Lawyer's Afterthought, Not Even Suggested In The Patent.

What petitioner now dubs the "secret of the success" of its Haybine machine is "the aggressive upper roller and the greater speed of the rollers than of the reel". Petitioner adds (Pet., p. 9):

> "This combination means that the crop is drawn through the conditioning rolls at a significantly faster speed than the crop is harvested and deposited in front

> of the rollers. The consequent thinning of the crop prevents clogging and allows the 'Haybine' to operate without problems with all types of forage crops."

Study of the patent exposes as a mere afterthought of counsel the "combination" which petitioner now urges. An afterthought, be it noted, which was rejected by the District Court (12a), and rightly so (*Graham* v. *John Deere Co.* (1966), 383 U.S. 1, 25; *Lincoln Engineering Co.* v. *Stewart-Warner Corp.* (1938), 303 U.S. 545, 550). The patent is barren of any reference to "thinning out" or "attenuation", and the claims in suit convey no hint that the "combination" of high roller speed and aggressive upper roll accomplishes anything of special note. In fact, of the three claims in suit (9b-10b), claim 13 does not even mention roller speed or the use of an aggressive roller surface, and claim 16 provides that the aggressive surface may be on *either* of the rollers—upper or lower or both! Only claim 20 affirmatively calls for an upper roll with an aggressive surface, and the real stature of that feature in the patentee's mind may be judged from the fact that claim 20 is a "dependent claim"—i.e., a mere tagalong.

The "feature" of rotating the rollers more rapidly than the reel was of course not new at all; the Crose machine admittedly did that (25b-26b). And aggressive roller surfaces were "old hat" in agricultural machinery (24b-25b). Hence the courts below were surely right in holding petitioner's alleged improvements obvious and unpatentable.

C. Respondent Did Not "Copy" Petitioner's Haybine Machine. Nor Did Respondent Do Any "Forum-Shopping".

In this Court, as in the tribunals below, petitioner airs the charge that respondent "copied" the Haybine machine (Pet., 10-12, 18).

That charge, even if it were true, is irrelevant; the issue before the Court is whether petitioner "invented" anything patentable. And the record proves, anyway, that the copying charge is *not* true.

It is a fact, of course, that respondent's mower conditioner is similar to petitioner's Haybine machine with respect to size, function, and general appearance, just as Ford's four-door sedan is similar in those respects to the four-door sedans made by Chevrolet and Plymouth (37b). Anent structural details, however, one finds the machines different in many ways. With respect to the reel, for example, the speed range in the Haybine is between 42.9 and 70 RPM, whereas in respondent's machine the speed range is 58 to 68 RPM (38b). And relative to their conditioning rolls, the two machines contrast sharply; respondent's machine uses rolls of equal diameter, whereas in the Haybine machine the upper roll is smaller than the lower one, and the speeds of the rolls in the two machines are markedly different (38b-39b).

True it is that the arrangement of the cutter bar, reel, guide ramp, and rolls in respondent's mower-conditioner is generally like that of the corresponding components in the Haybine, but it is even *more similar* to the arrangement of the same parts in the old Crose machine (36b)!

Petitioner notwithstanding, additional proof that respondent did *not* copy the Haybine is afforded by (a) the fact that respondent's original mower conditioner had its aggressive roll on the bottom, and (b) the further fact that the roll positions were reversed in respondent's machine only after a full year of production, during which feeding problems were experienced in some of the crop conditions in which respondent's machine was used. (See Petition, pp. 11-12, 26.) Obviously, had respondent's engineers really been copying the Haybine, they would have put the aggressive roll on the top from the very start. Their failure to do so does not prove, as petitioner would have it, that respondent's engineers were not competent enough to do a good job of copying; what it does prove is that respondent's original design was *not a copy*, and that the roll reversal in respondent's second model resulted from *field experience*.

Another *ad hominem* argument which petitioner has invoked repeatedly (Pet., pp. 7, 13, 24, 28) is the pretension that respondent's decision to commence this action in the United States District Court at Fresno, California, was "forum-shopping".

That charge, like the "copying" charge, is untrue, and petitioner should be ashamed of itself for making it. This action was filed at Fresno because the people most intimately familiar with the Crose machine, and with its construction and field use, were residents of the Central Valley of California, within the subpoena jurisdiction of the District Court at Fresno. Hence, by suing where it did, respondent was able to bring personally before the District Court, as trial witnesses, Harvey L. Crose himself, Crose's shop foreman Ray Wells, Marion R. Kattenhorn, who made his living for five years by harvesting

hay with a Crose machine, William Roe, on whose land most of Kattenhorn's work was done, and five of Kattenhorn's neighbors at Shandon, California, where Roe's land was located.*

II. Legally Unsound Also Are Petitioner's "Reasons For Granting The Writ". The Rule Of The A&P Case Is Not Dead, And Mere Aggregations Are Not Patentable, Petitioner's Wishful Thinking Notwithstanding.

As just pointed out, petitioner's portrayal of itself as the victim of injustice is grounded from start to finish on factual premises that are not true. And, as we shall now show, petitioner's legal argument is of no better quality than its factual premises.

The theme of petitioner's legal argument (Pet., pp. 2-7, 20-30) is that the enactment of §103 of the Patent Act of 1952 struck from the law the rule of *Great A & P Tea Co.* v. *Supermarket Equipment Corp.* (1950), 340 U.S. 147, under which an assemblage of old elements may not be patented unless the old elements in concert contribute some result greater than the sums of their previously known individual functions.

In other words, without saying so explicitly, petitioner is asking this Court to hold that mere aggregations of old elements are now patentable, by act of Congress.

That argument is unsound and must fail, because Congress, even if it wished to, is *forbidden by the Constitution to authorize such monopolies.*

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* Had petitioner been forthright, it would have told this Court about its unsuccessful motion for transfer, denied by the District Court primarily because of the availability at Fresno of key witnesses.

The point petitioner now urges was specifically considered in *Anderson's-Black Rock, Inc.* v. *Pavement Salvage Co., Inc.* (1969), 396 U.S. 57, 60-63, a unanimous decision of this Court, and petitioner's position was rejected. Therein, this Court held that, §103 notwithstanding, no valid patent may issue on a combination of old elements in which the individual elements perform only their known, conventional functions, without any "synergistic result". In so holding, this Court restated thus (396 U.S., at 61) its views previously announced in *Graham* v. *John Deere Co.* (1966), 383 U.S. 1, 6, concerning the constitutional standard of invention:

> "The patent standard is basically constitutional. Article I, §8, of the Constitution authorizing Congress '[t]o promote the Progress of . . . useful Arts' by allowing inventors monopolies for limited times. We stated in *Graham* v. *John Deere Co.*, 383 U.S. 1, 6, that under that power Congress may not 'enlarge the patent monopoly without regard to the innovation, advancement or social benefit gained thereby. Moreover, Congress may not authorize the issuance of patents whose effects are to remove existent knowledge from the public domain or to restrict free access to materials already available. Innovation, advancement, and things which add to the sum of useful knowledge are inherent requisites in a patent system which by constitutional command must "promote the Progress of . . . useful Arts." This is the *standard* expressed in the Constitution and it may not be ignored.'" (Emphasis in original.)*

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* Emphasis in quotations has been added herein, except where otherwise noted.

In *John Deere* (1966), 383 U.S. 1, 5-6, this Court explained thus the restraint imposed upon the powers of Congress by Article I, §8, cl. 8, of the Constitution:

> "The clause is both a grant of power and a *limitation*. This qualified authority, unlike the power often exercised in the sixteenth and seventeenth centuries by the English Crown, is limited to the promotion of advances in the 'useful arts.' . . . The Congress in the exercise of the patent power *may not overreach the restraints imposed by the stated constitutional purpose.*"

This Court added (383 U.S., at 6):

> "Within the scope established by the Constitution, Congress may set out conditions and tests for patentability. . . . It is the duty of the Commissioner of Patents and of the courts in the administration of the patent system to *give effect to the constitutional standard* by appropriate application, in each case, of the statutory scheme of the Congress."

The lesson clearly taught by the *John Deere* and *Black Rock* cases (but seemingly lost on petitioner) is that §103's restriction of patentability to non-obvious subject matter is not a *substitute* for the constitutional standards of patentability spelled out in such leading cases as *Great A & P Tea Co.* v. *Supermarket Equipment Corp.* (1950), 340 U.S. 147, and *Lincoln Engineering Co.* v. *Stewart-Warner Corp.* (1938), 303 U.S. 545, but rather is an *additional* "prerequisite to patentability" (*John Deere*, 383 U.S., at 17).

In other words, a patent must be held invalid *without any inquiry into obviousness* if it fails to pass the constitutional tests prescribed in the *A & P* and *Lincoln Engineering* cases; but, even if a patent passes those tests, it

still, by virtue of §103, cannot be held valid unless it *also* meets the non-obvious requirement.

Nor do the cases support petitioner's argument that this Court's decision in the *A & P* case is no longer respected outside the Ninth Circuit, and that the "new and surprising result" test applied by the Court of Appeals for the Ninth Circuit in adjudicating patents covering purported "combinations" of individually old elements is in conflict with the tests applied in the Second, Tenth and District of Columbia Circuits.

Thus, petitioner cites *Shaw* v. *E. B. & A. C. Whiting Company* (2 Cir., 1969), 417 F.2d 1097, as authority for the proposition that the Second Circuit has substituted a simple "obviousness versus non-obviousness" test for the "new and surprising result" test prescribed by this Court in *A & P*. But the following excerpts from Judge Waterman's opinion in the *Shaw* case clearly refute that argument:

1. "Dr. Kidd, head of the British Brush Manufacturers Research Association when Shaw's filament was first brought to his attention in 1957, testified that he was quite *surprised* that someone could produce a linearly oriented filament of a precise X-shape because his previous experience had taught that the process of stretching or tension drawing would tend to distort the filament's shape or to round it out" (417 F.2d 1105).

2. "Dr. Kuehne, a professor at the University of Vermont and an expert in organic chemistry, testified that the Shaw filament posed for him an *unexpected result* because the stretching process would tend to induce, on the basis of chemical or molecular theory, a loss in filament shape, causing it to become more circular" (417 F.2d 1105).

And the decisions of the Courts of Appeal for the Tenth and District of Columbia Circuits cited by petitioner (*A. E. Staley Manufacturing Co.* v. *Harvest Brand, Inc.* (10 Cir., 1971), 452 F.2d 735, cert. denied (1972), 406 U.S. 974; *Corning Glass Works* v. *Brenner* (D.C.Cir., 1972), 470 F.2d 410) leave no doubt that both those Courts still respect and follow this Court's decision in the *A & P* case, for they unequivocally hold that the achievement of a "new result" (452 F.2d 738; 470 F.2d 420) or an "unexpected result" (470 F.2d 420) is one of the tests to be applied in determining the validity of patents on assemblies of individually old components.*

There is, in short, no foundation for petitioner's contention that the patentability test applied by the Court of Appeals for the Ninth Circuit in this case is in conflict with the tests being applied by the other Courts of Appeals, or with this Court's decisions in the *John Deere* and *Black Rock* cases.

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* Indeed, the language quoted by petitioner from the Tenth Circuit's decision in the *Staley* case (Pet. 15, footnote 11) is itself a quotation from that Court's earlier opinion in *Bewal, Inc.* v. *Minnesota Mining and Manufacturing Co.* (10 Cir., 1961), 292 F.2d 159, 164, in which this Court's *A & P* decision was not only cited but in which the following excerpt from that decision was set forth in full:

> "'The conjunction or concert of known elements must contribute something; only when the whole in some way exceeds the sum of its parts is the accumulation of old devices patentable'" (292 F.2d 164).

The rule expressed in that excerpt from the *A & P* case was, of course, reiterated by this Court in its *Black Rock* decision, when it said that a valid patent cannot be obtained on an assembly of old elements unless they achieve a "synergistic result" (396 U.S. 61).

CONCLUSION

The petition for writ of certiorari must be denied, since it has neither factual nor legal merit.

Respectfully submitted,

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